UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,257	10/21/2003	Oscar A. Chappel	92717-345USP1	3421

	EXAMINER
7590 12/12/2006	BUSS, BENJAMIN J

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ART UNIT	PAPER NUMBER
2129	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/690,257	CHAPPEL, OSCAR A.
	Examiner	Art Unit	
	Benjamin Buss	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 October 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*1-21*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>*1-21*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>*10/23/2006, 12/4/2006*</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

This Office Action is in response to an AMENDMENT entered 10/2/2006 for the patent application 10/690,257 filed

on 10/21/2003, which claims priority as a **continuation-in-part** of 10/336,104 filed on 1/3/2003, which is a

continuation-in-part of 09/859,320 filed on 5/16/2001. Examiner also acknowledges Applicant's incorporation of

5   10/690,258 filed on 10/21/2003. The First Office Action of 7/17/2006 is fully incorporated into this FINAL Office

Action by reference.

Status of Claims

Claims 1-21 are pending.

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MPEP 2111 states that during patent examination, the pending claims must be "given their broadest

reasonable interpretation consistent with the specification." The Examiner has determined the broadest reasonable

interpretation of the claims based on the terms used. Claim 1 is interpreted to be met by:

- Any comparison between a converted input and a rule, wherein the rule is used to in populating a

15   knowledge base based on patterns;

- Doing anything based on the result of the comparison, such as

- Storing something as a result of the above.

Examiner suggests that Applicant consider further defining at least the following broad terms **in the claims**:

20   - Claim

- Conclusion variable

- Edit

- Expanding

- Filtering

25   - Rule

- Syntax

- Translated edit

- Translating

- Validating

- Verifying

Response to Arguments

Applicant's arguments filed 10/2/2006 have been fully considered but they are not persuasive. In re pgs. 8-9,

5   Applicant argues that the Office Action interpretation is unreasonable as inconsistent with the specification. Since

the terms "translated edit" and "method call" are not further defined in the claims, Examiner is obligated to read the

terms broadly. Applicant points out that the specification states what the edits **may** be (Remarks p8 quoting

Specification p10 L11-16), but the Examiner points out that the Specification treats this as a possibility rather than a

definition, so the term is still open to interpretation. Similarly, "method call" is not defined in the specification.

10 Furthermore, a "method call" would have been understood by the person of ordinary skill in the art at the time of the

invention to include any execution of a programming function (method) on any inputs with any outputs. Examiner's

interpretation is not inconsistent with the specification, but rather merely broadly interpretive of the disclosed

subject matter based on plain meanings and known knowledge to which Applicant has left the claims open.

There is no mention of the limitations argued by Applicant found in the claims and the specification is not

15 the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the

purpose of avoiding the prior art; see In re Sprock, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

20   Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
        matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions
        and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject

25 matter. The computer system must set forth a practical application of that §101 judicial exception to produce a real-

world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. The invention is ineligible because it has not been

limited to a substantial practical application. The claims are directed to abstract manipulation of abstract data, the

data being labeled as an "edit", and are therefore directed to mere abstract ideas.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken

30 to achieve a particular result are useful, tangible, and concrete. If the claim is directed to a practical application of

the §101 judicial exceptions producing a result tied to the physical world that does not **preempt** the judicial

exception, then the claim meets the statutory requirement of 35 U.S.C. §101.

The phrase "populating the knowledge base" is not clear in purpose or scope. The claims neither

encompass a physical transformation nor do they produce a useful, concrete, tangible result. The knowledge base

5   is interpreted to be abstract.

The invention must be for a practical application and either:

        1) specify transforming (physical thing – article) or

        2) have the Final Result (not the steps) achieve or produce a

                useful (specific, substantial, AND credible),

10   concrete (substantially repeatable/non-unpredictable), AND

                tangible (real world/non-abstract) result

                (tangibility is the opposite of abstractness).

A claim that is so broad that it reads on both statutory and non-statutory subject matter must be amended,

and if the specification discloses a practical application but the claim is broader than the disclosure such that it does

15   not require the practical application, then the claim must be amended.

Claims that manipulate abstract data through rule-based filtering, determine abstract matches, and

populate an abstract knowledge base are not statutory. Furthermore, such claims preempt all possible pre-

processed knowledge base population uses in a myriad of real world practical applications, such as video

knowledge-bases used for facial recognition or video searches, audio knowledge-bases for music cataloging or

20   speech recognition, financial knowledge-bases for detecting money laundering or credit fraud, customer data-bases

for data-mining of spending habits, medical data-bases for detecting disease symptoms or risk conditions, etc.

        -      Appropriate corrections are required.

Response to Arguments

Applicant's arguments filed 10/2/2006 have been fully considered but they are not persuasive. In re pgs. 9-10,

25   Applicant argues that "a populated knowledge base is a useful, concrete, and tangible result with many practical applications,

at least one of which is set forth in the specification" and that the claims are not directed to abstract manipulation of

abstract data because the "specification defines not only *edit*, but also *translated edit* and also points out that the term *edit* is

well known in the art".

Examiner disagrees. While a populated knowledge base **may** be a useful, concrete, and tangible result for

an application, this is only true when the knowledge base is populated with <u>real world data</u> specific to the particular

practical application. A singular populated knowledge base is **not**, in general, useful to "many practical

applications", but rather only is useful to the relatively few practical applications to which it has been tailored to

5   serve. Applicant is attempting to ***preempt*** all possible practical application of a populated knowledge base.

Furthermore, *absent population with real world data for a specific practical application*, a populated

knowledge base is ***not*** a useful, concrete, and tangible result for a substantial practical application in and of itself.

In the case where the knowledge base is populated with abstract data, the knowledge base amounts merely to an

abstract manipulation of abstract ideas.

10   Finally, the mere existence of a populated knowledge base is not inherently a useful, concrete, and tangible

result for a substantial practical application **even if** it is populated using real world data specific to the particular

practical application in question ***unless*** it is made **accessible and available** to a user, process, machine, etc.

which is capable of understanding and using the knowledge stored in the populated knowledge base.

Absent recitations to remedy these deficiencies, the rejection of claims 1-21 under 35 U.S.C. §101 as

15   directed to non-statutory subject matter STANDS.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections

under this section made in this Office action:

20   A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an
international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
25   subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by **Green** (USPGP 2002/0040359).

Claims 1, 8, & 15:

Green anticipates:

-   Filtering a translated edit via at least one knowledge-base-population rule to determine a match between a syntax of the translated edit and a syntax of the knowledge-base-population rule (p1-22 especially "standardization may encompass linguistics and syntax as well as any other matters that facilitate transformation" ¶10 and "content is converted into a standardized content reflecting standardized terminology and syntax" ¶12 and "conversion process is preferably conducted based on a knowledge base" ¶13 and "mapped to standardized semantic elements" ¶13 and "compares all possible parse sequences" ¶414);

-   Executing a method call responsive to the filtering step resulting in at least one match being determined (p1-22 especially "can then be mapped to standardized semantic elements" ¶13 and "parse at least a portion of the database into a set of source semantic elements and identify individual elements for potential processing" ¶14 and "using the converted content in transforming a communication" ¶11 and "module ¶348 and "call 'adaptors' or 'integration servers' that translate ERP content, structures, and formats, from one system environment to another" ¶363 and "API that is called by Java clients (such as a JSP server process) to retrieve translations" ¶430 and "Run machine translation module" Figure 12 item 1220 and associated discussion);

-   Populating the knowledge base responsive to the executing step (p1-22 especially "establishing corresponding tables of a relational database defining a corresponding XML tagging structure and/or establishing other definitions and logic for handling structured data" ¶15 and "convert at least a portion of the input content into a third semantic environment, thereby defining a converted content" ¶11 and "knowledge base developed from analysis of a quantity of information reflecting the first semantic environment" ¶13);

-   Wherein the knowledge base comprises a collection of facts and rules (p1-22 especially "Grammar Rules" ¶165 and "basic fact that the rule is intended to capture" ¶186 and "grammar rules formalism, that fact may be indicated" ¶214 and "besides category labels, the foregoing example included two kinds of things in rules" ¶264 and "rules/grammar base" ¶304 and "joining rules" ¶111); and

- Wherein the at least one knowledge-base-population rule represents a pattern, the pattern being a combination of variables and constants in a specified order (p1-22 especially "Syntax relates to the phrasing, ordering and organization of terms as well as grammatic and other rules" ¶3 and "ordering rules" ¶23,¶75,¶130,¶142 and "another rule, of the form all x consist of the sequence a followed by b" ¶197 and

5   "grammatical sequences of words" ¶389 and "count the sequences of words in a body of text in order to measure the odds that a particular word appears after a particular sequence" ¶399).

Claims 2, 9, & 16:

Green anticipates:

10   - Translating an edit to yield the translated edit (p1-22 especially "transforming content form a first semantic environment to a second semantic environment by first converting the input data into an intermediate form" ¶11).

Claims 3, 10, & 17:

15 **Green** anticipates:

- Binding at least one conclusion variable responsive to the filtering step (p1-22 especially "transformation matrix" ¶13).

Claims 4, 11, & 18:

20 **Green** anticipates:

- Expanding the at least one conclusion variable (p1-22 especially "establishing corresponding tables of a relational database defining a corresponding XML tagging structure and/or establishing other definitions and logic for handling structured data" ¶15 and "changes to make to the normalization and translation knowledge bases in order to improve the quality of the translation" ¶348); and

25   - Creating an instance of a code object corresponding to the called method (p1-22 especially "XML tagging" ¶15 and "call "adaptors" or "integration servers" that translate ERP content, structures, and formats, from one system environment to another" ¶363 and "API that is called by Java clients (such as a JSP server process) to retrieve translations" ¶430).

Claims 5, 12, & 19:

Green anticipates:

5
- Validating a claim using the populated knowledge base (p1-22 especially "NLE checks each line of the data individually to see if any of the rules seem to apply to that line" ¶286 and "Assess accuracy of translated item" Figure 4 item 416 and "Review translation results" Figure 12 item 1222 and associated discussion of these figures and items).

Claims 6, 10, & 20:

10 **Green** anticipates:

- Adding information contained in the created code-object instances to the knowledge base (p1-22 especially "changes to make to the normalization and translation knowledge bases in order to improve the quality of the translation" ¶348).

15 **Claims 7, 10, & 21:**

Green anticipates:

- Verifying that the edit has been correctly translated (p1-22 especially "Assess accuracy of translated item" Figure 4 item 416 and "Review translation results" Figure 12 item 1222 and associated discussion of these figures and items).

20   *Response to Arguments*

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

                                             Conclusion

25 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing

date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and

the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

5   37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Eldridge (USPGP 2001/0037224)

10   - Tyler (USPN 5,523,942)

- Skeirik (USPN 4,920,499)

- Reijerse (USPGP 2003/0130991)

- Loeb (USPN 6,725,287)

- Levin (USPN 6,311,173)

15   - Skidmore (USPN 5,488,714)

- Wollaston (USPN 6,061,506)

- Avinash (USPGP 2004/0122709)

Claims 1-21 are rejected.

20

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed

to Benjamin Buss whose telephone number is 571-272-5831. The examiner can normally be reached on M-F 9AM-

5PM.

As detailed in MPEP 502.03, communications via Internet e-mail are at the discretion of the applicant.

Without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet

correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122.

A paper copy of such correspondence will be placed in the appropriate patent application. The following is a sample

5   authorization form which may be used by applicant:

      "Recognizing that Internet communications are not secure, I hereby

      authorize the USPTO to communicate with me concerning any subject

      matter of this application by electronic mail. I understand that a copy of

      these communications will be made of record in the application file."

10   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent

can be reached on 571-272-3080. The fax phone number for the organization where this application or proceeding

is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information

Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or

15   Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more

information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20

                  Benjamin Buss
                  Examiner
                  Art Unit 2129

BB

                             12/11/06

                            DAVID VINCENT
                       SUPERVISORY PATENT EXAMINER